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SCOTT EVANS

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27776

7590

02/06/2009

WARD & OLIVO

SUITE 300

382 SPRINGFIELD AVENUE

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EXAMINER

DANNEMAN, PAUL

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/267,840	Applicant(s) EVANS, SCOTT	
	Examiner PAUL DANNEMAN	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 December 2008 has been entered.

Status of the Claims

2. Claims 41-64 are pending and have been examined in this application.
3. Independent Claims 41 and 54 have been amended.

Response to Arguments

4. Applicant's arguments with respect to claims 41-64 have been considered but are moot in view of the new ground(s) of rejection.

Drawings

5. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because most all the drawings contain hand-written annotations and Fig.1-3, 9-14, 16, 19-20, 22-23, 25, and 29 are not legible. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 46 and 57** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the term “appropriate” makes it impossible to ascertain the “metes and bounds” of the advertising materials appropriate for the user. Correction is required.

8. **Claims 53 and 64** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the term “clearing said database” makes it impossible to ascertain the “metes and bounds” of the action being performed on the database. Correction is required.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. **Claims 41-43, 45-53, 54 and 56-64** are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes

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the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. **Claims 41-64** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein, US 6,298,335 B1.

14. **Examiner's note:** Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully

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the **entire** reference as potentially teaching all or part of the claimed invention, as well as the content of the passage as taught by the prior art or disclosed by the Examiner.

Claims 41 and 54:

With regard to the limitations:

- *Establishing information and business rules common to members of each transaction community stored in a database;*
- *Establishing and communicating an Internet address associated with one particular transaction community;*
- *Accessing, via said internet address by a user to allow interactive exchange of information with a creditor to resolve a pre-existing bill, debt or other transaction;*
and
- *Providing one user at least one option for resolving a pre-existing bill, debt or other transaction according to established information and business rules.*
- *Transaction community is an account pool and associated electronic communication interfaces for the creditor and user to conduct an interactive exchange of information; and*
- *Wherein at least one option of negotiating the pre-existing bill, debt or transaction is an option of paying a portion of the pre-existing bill, debt or transaction.*

Bernstein in at least Column 2, lines 16-25 discloses a method and apparatus for executing payment of a debt by a person to a payee. The method includes the steps of negotiating payment terms with the payee and entering the negotiated payment terms into a payment schedule. The method further includes the steps of determining by the scheduler that the payment is due on the debt in accordance with the payment terms and electronically instructing the third party to pay the debt due and electronically transferring a receipt of the payment to the person and payee and to a database of the person in a secure location, remote from the person.

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Bernstein in at least FIG.1 and FIG.2 discloses the use of the Internet for conducting the negotiations between the creditor and user. Bernstein in at least Column 4, lines 8-13 using a webpage for negotiating the payment options between the creditor and user. Bernstein in at least Column 2, lines 50-57 and Column 4, lines 32-41 further discloses memorandums being created and associated with each transaction and numerous data fields being exchanged between buyer and seller.

Bernstein in at least Column 4, lines 42-57 further discloses that the payment source may be a credit card company, a bank, a credit union, a non-bank financial institution, or simply a clearinghouse for payments of debts by electronic means.

Claim 42:

With regard to the limitation:

- ***User may provide information selected from the group consisting of an account number, and account specific information.***

Bernstein in at least Column 4, lines 14-25 discloses the transfer of sensitive information (e.g., the credit card number or PIN number) in encrypted format.

Claim 43:

With regard to the limitation:

- ***Interactive exchange includes authorizing a payment transaction with creditor that can be processed, funded and reported by the system through use of user account specific information.***

Bernstein in at least Column 4, lines 32-41 discloses in at least Column 4, lines 66-67 and Column 5, lines 1-13 agreement between the creditor and user authorizing a payment transaction based on account specific information.

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Claims 44 and 55:

With regard to the limitation:

- ***The user utilizes an internet website, an interactive voice telephone system, a live operator, an electronic kiosk, or a customer service center to access a transaction community using a system access code.***

Bernstein in at least FIG.1 and FIG.2 discloses the use of the Internet for conducting the negotiations between the creditor and user. Bernstein in at least Column 4, lines 8-13 using a webpage for negotiating the payment options between the creditor and user.

Bernstein in at least Column 4, lines 14-25 discloses the transfer of sensitive information (e.g., the credit card number or PIN number) in encrypted format.

Claims 45 and 56:

With regard to the limitation:

- ***Consolidating payments received from users such that collected payments are properly allocated to said creditors.***

Bernstein in at least Column 4, lines 8-13 discloses the vendor providing the buyer with a webpage summarizing various acceptable payment options with the buyer being able to propose other options or selecting an offered mode of payment (e.g., credit card). Bernstein in at least Column 4, lines 32-41 further discloses the use of a unique transaction number generated by either the buyer or seller and associated with the transaction record of each party. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to modify Bernstein's use of a "unique transaction number" with a method for consolidating payments and allocating them to the proper creditor with the motivation to increase customer satisfaction for the creditor and user.

Claims 46 and 57:

With regard to the limitation:

- ***Providing user with advertising materials appropriate for said user.***

Bernstein does not specifically disclose the use of advertising materials; however it would have been obvious, at the time of the invention, to one of ordinary skill, to modify Bernstein debt payment system with advertisement material appropriately directed to the user with the motivation to inform the user of the benefits of a debt repayment plan/agreement.

Claims 47 and 58:

With regard to the limitation:

- ***Allowing the user to access information unrelated to said bill or said debt, said unrelated information including financial, employment or demographic information.***

Bernstein does not specifically disclose allowing the user to access information unrelated to said bill or said debt, however per applicant's admission in paragraphs [0002 - 0007] the Internet is the "superhighway" of computers which allows a network user to connect and link up with computers around the world. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill, to modify Bernstein's portal accessible via the "superhighway" with the capability to link to "unrelated information" including financial, employment or demographic with the motivation of providing a user with access to information which may both informative and helpful in addressing debt.

Claims 48-49 and 59-60:

With regard to the limitation:

- ***Allowing said user to resolve said bill or debt using their checking account;***
- ***Verifying the availability of funds in said checking account prior to resolving said debt or said bill.***

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Bernstein in at least Column 3, lines 51-59 discloses a user settling a debt using various types of checks (electronic check, and extended check settlement). Bernstein specifically discloses an "electronic check" as one which results in an instantaneous transfer of funds. Bernstein does not specifically disclose verifying the availability of funds per se, however in at least Column 4, lines 18-25 discloses a credit card being used for payment of a debt and the vendor being notified if the credit card is "over the limit" and requesting the buyer to select another form of payment. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to modify Bernstein's "electronic check" with an instantaneous notification of "insufficient funds" with the motivation of allowing the user to select an alternative method to settle a debt.

Claims 50 and 61:

With regard to the limitation:

- ***Reporting said interactive exchange of information to said database.***

Bernstein in at least Column 2, lines 16-25 discloses "electronically transferring a receipt of the payment to the person and payee and to a database." Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill, to modify Bernstein's database to include a record of any creditor and user interactive exchange with the motivation of having a clear record for quality purposes.

Claims 51 and 62:

With regard to the limitation:

- ***Providing a report of transaction information accessible by said user or said creditor.***

Bernstein in at least Column 2, lines 50-57 and Column 4, lines 32-41 further discloses memorandums being created and associated with each transaction and numerous data fields being exchanged between buyer and seller. Bernstein in at least Column 4, lines 32-41 further discloses the use of a unique transaction number generated by either the buyer or seller and

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associated with the transaction record of each party. Bernstein in at least Column 4, lines 58-67 and Column 5, lines 1-13 further discloses a record and settlement date for each transaction with a creditor scheduler which compares the current date with a payment schedule agreed up by the user. Bernstein in at least Column 5, lines 42-48 further discloses a receipt for a transaction being held in the archive 22 and forming a permanent record of the creditor and user transaction. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to modify Bernstein's use of a "unique transaction number and record" with a method for allowing the creditor or user to access the recorded information using a report generator to provide a record to either creditor or user on past transaction information with the motivation of providing transaction information that is useful to both the creditor and user.

Claims 52-53 and 63-64:

With regard to the limitation:

- ***Wherein the information and business rules are selected from a group consisting of coordination of service termination status accounts, minimum payment requirements, payment method limitations, and payment method privilege suspension.***
- ***Allowing said information and business rules to be applied at user entry; and clearing said database prior to reporting to reduce invalid or unknown transactions.***

Bernstein in at least Column 4, lines 43-56 discloses a payment policy being determined by a third party. Bernstein in at least Column 4, lines 66-67 and Column 5, lines 1-10 discloses a settlement date for an ECS check which will only be honored over a particular period of time.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627

3 February 2009

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627